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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor : Bertram V. Burke
Serial No. : 09/314,424
Filed : May 18, 1999
For : Voucherless Rebate System
Art Unit : 2162
Examiner : Jean D. Janvier
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Hon. Commissioner of Patents & Trademarks
Washington D. C. 20231

AMENDMENT

Sir:

Submitted herewith is a complete set of claims showing amendments to the claims. Also attached are amendments to the specifications. Claims 1 to 27 remain in the application.

The Examiner is respectfully thanked for the interview courteously granted applicant's counsel on March 25, 2003 to discuss the draft amendment submitted March 7, 2003. The substance of the interview will be evident from the following.

Reconsideration is respectfully requested of the comments concerning the abstract.

Applicant is submitting a new abstract adopting the Examiner's suggestion.

Reconsideration is respectfully requested of the objections to claims 4 and 10, 6

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and 11. These claims have been amended to avoid the objections thereto. Counsel understood the Examiner to agree that these amendments are acceptable.

Claim Rejections- 35 U.S.C. §101

Reconsideration is respectfully requested of the rejection of claims 1 to 7 under 35 U.S.C. §101 as directed to non-statutory subject matter on the grounds that the steps need to be automated or computer implemented.

Applicant has amended the claims to overcome this rejection by adopting aspects of the Examiner's suggestion. The claims now specify computer implementation with code, when executed to perform specific functions. Counsel understood the Examiner to agree that these amendments are acceptable.

As To Rejections Under 35 U.S.C. §103

Reconsideration is respectfully requested of the rejection of claims 1 to 27 under 35 U.S.C. §103 as unpatentable over Burke US Patent 5,621,640 in view of Hovakimian, US Patent 5,466,919. As in the draft amendment, applicant is claiming the benefit of Burke 5,621,640, through a series of applications. Thus Burke should be removed as reference in this application. The Examiner has thus far refused. The claim of the benefit of the earlier applications is maintained. The reasons therefore are discussed further at the end of this amendment.

Reconsideration is further respectfully requested of the rejection of claims 1 to 27

under 35 U.S.C. §103 as unpatentable over Burke US Patent 5,621,640 in view of Hovakimian, US Patent 5,466,919 for the following reasons. The claims are believed to be distinct and non-obvious from these references alone or in combination by virtue of:

"deducting from the purchases of the supporter from said merchant the calculated rebates determined by the merchant and forwarding to said nonprofit the calculated and deducted rebates to be paid by the merchant to said nonprofit", in claim 1;

"transmitting to the organizations the rebates, deducted from purchases of the supporter from said merchants in said transactions between said supporter and the merchants, and to be given to the organizations" in claims 2 to 6;

"transmitting, to the organizations, the amount of rebates determined by the merchants and due the organization from each of the merchants", in claim 7;

"having payments credited, on the basis of said transactions and said rebate calculations determined by said merchants, from said merchants to said nonprofit organizations"; in claims 8 to 11.

The new claims are further believed to be distinct and non-obvious from any combination of the aforementioned references by virtue of the features particularly cited therein.

None of the references, alone or in combination, suggests these features or in any sense makes the claims obvious. In Burke, it is the customer that chooses an amount and adds the amount, chosen by the customer, to the total charged by the merchant, and the

clearinghouse sends the **added amount** to a charity or other destination. In the claimed invention, the **merchant determines the amount to rebate from the total** charged by the merchant, and that amount is rebated to the destination organization.

Hovakimian adds nothing to the aforementioned, alone or combined, to make the claims obvious. In Hovakimian, the purchaser makes the donation, not the merchant.

The **Examiner** admits that Burke does not disclose or suggest a method and/or system for deducting calculated rebates, as determined by a merchant or retailer, based on purchases made by a supporter or customer or donor at the merchant's or retailer's to thereby forward, for payment by the merchant or retailer, the calculated and deducted rebates to a non-profit organization or charity. The Examiner mentions Hovakimian. However, the **Examiner** never even alleges or concludes that Hovakimian suggests that the **merchant determines the amount to rebate from the total**. Rather the **Examiner** admits that in Hovakimian:

"the issuer of the credit card agrees to deduct a certain portion (calculated rebates) from each identified purchaser's transaction involving the credit card and subsequently donate the accumulated portions or rebates to the charity or charities pre-selected by the identified purchaser or customer in an effort to encourage the identified purchaser to use the credit card to pay for transactions."

In the Examiner's own words, it is the credit card company that makes the

donation. Nowhere does the Examiner even allege that Hovakimian suggests that it is the merchant's decision or money that is involved. In fact the Examiner goes on by admitting that incorporating

"the teachings of Hovakimian into the Burke's system so as to encourage an identified customer or purchaser to use a specific manufacturer's or issuer's credit or debit card to pay for transactions at participating merchants by agreeing to deduct a certain portion (calculated rebates) from each identified purchaser's transaction involving the credit card and subsequently donate the accumulated portions or rebates to the charity or charities pre-selected by the identified purchaser or customer, wherein the accumulated rebates represent the issuer's own money, thereby yielding to immediate customer's gratification and acceptance of the said credit card,..."

Neither Burke nor Hovakimian suggest, **"deducting from the purchases of the supporter from said merchant the calculated rebates determined by the merchant and forwarding to said nonprofit the calculated and deducted rebates to be paid by the merchant to said nonprofit"**.

The present application claims the benefit of pending Serial Number 09/611,905 filed July 7, 2000; which is a continuation of Serial Number 08/429,758 filed April 27, 1995, now Patent Number 6,112,191; which in turn is a continuation-in-part of Serial Number 08/349,353 filed December 5, 1994, now Patent Number 5,621,640; which is a

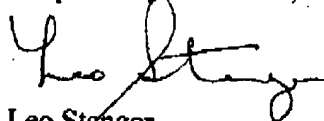
continuation of Serial Number 08/018,821 filed February 18, 1993, now abandoned. Applicant also claims the benefit of pending Serial Number 09/609,777 filed July 5, 2000; which is a continuation of Serial Number 08/843,424 filed April 15, 1997 now Patent Number 6,088,682; which is also a continuation-in-part of the aforementioned Serial Number 08/349,353 filed December 5, 1994, now Patent Number 5,621,640; which is a continuation of Serial Number 08/018,821 filed February 18, 1993, now abandoned. Each aforementioned application claims the benefit of the earlier application.

The present application was filed on May 18, 1999, prior to November 29, 2000, the effective date of the portion of 37 C.F.R. 1.78 establishing time limits for claiming the benefit of earlier filing dates.

As an alternative, any disclosure in Burke 5,621,640 cannot be used as a reference against the present application. Hovakimian 5,466,919 has an effective filing date of April 2, 1993, after the first effective filing date of February 18, 1993, of the Burke 5,621,640 patent. Thus this patent is also not a valid reference.

In view of the above it is respectfully requested that the claims be allowed and the case pass to issue.

Respectfully submitted,



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